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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,563	09/12/2000	Gregory L. Slaughter	5181-64900	6903
7590	10/18/2005		EXAMINER	
Robert C Kowert Conley Rose & Tayon PC P O Box 398 Austin, TX 78767-0398			LESNIEWSKI, VICTOR D	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/660,563	SLAUGHTER ET AL.
	Examiner Victor Lesniewski	Art Unit 2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/7/2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. The appeal brief filed 3/28/2005 has been placed of record in the file.
2. Claims 1-30 are now pending.
3. In view of the appeal brief filed 3/28/2005, PROSECUTION IS HEREBY REOPENED.

New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Information Disclosure Statement

4. The IDS filed 4/7/2005 has been considered.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-9, 11-19, and 21-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent Number 6,643,650. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application recite limitations reciting the same scope as many of the claims of U.S. Patent Number 6,643,650 as presented below.

7. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a system or a carrier medium are rejected under the same rationale applied to the described claim.

8. U.S. Patent Number 6,643,650 similarly discloses:

- <Claims 1, 11, and 21>

A method comprising: a client reading an advertisement from a space, wherein the space comprises a network-addressable storage location, wherein the advertisement comprises a Uniform Resource Identifier (URI) and a schema, wherein the URI specifies a network address at which a service may be accessed, and wherein the schema specifies one or more messages usable to invoke one or more functions of the service; and the client sending a first message to the service at the URI, wherein the first message is specified in the schema (claims 1, 2, 3, 4, 7, and 9).

- <Claims 2, 12, and 22>

The method of claim 1, further comprising: the service sending a second message to the client in response to the client sending the first message to the service, wherein the second message is specified in the schema (claims 1 and 7).

- <Claims 3, 13, and 23>

The method of claim 1, further comprising: invoking one or more functions of the service in response to the client sending the first message to the service (claims 1, 3, and 4).

Further it is would have been obvious to actually invoke the function since the previous patent states that the messages are “usable to invoke one or more functions.”

- <Claims 4, 14, and 24>

The method of claim 1, wherein the schema is expressed in a data representation language (claims 1 and 7).

- <Claims 5, 15, and 25>

The method of claim 1, wherein the first message is expressed in a data representation language (claims 1 and 11).

- <Claims 6, 16, and 26>

The method of claim 5, wherein the data representation language comprises extensible Markup Language (XML) (claims 1 and 10).

- <Claims 7, 17, and 27>

The method of claim 1, wherein the URI comprises an Internet address (claims 1 and 2).

Further it was well known in the art that an Internet address is a type of URI.

- <Claims 8, 18, and 28>

The method of claim 1, further comprising: the service publishing the advertisement in the space (claim 1).

Further it would have been obvious that the advertisement was published in the space since the previous patent states its availability in the space and that the space “is operable to store” an advertisement.

- <Claims 9, 19, and 29>

The method of claim 1, further comprising: the client using a lookup service to find the advertisement in the space (claim 1).

Since U.S. Patent Number 6,643,650 similarly discloses all of the above limitations, claims 1-9, 11-19, and 21-29 are rejected.

9. Claims 10, 20, and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent Number 6,643,650 in view of the claims of U.S. Patent Number 6,789,126 as presented below.

10. The combination of U.S. Patent Number 6,643,650 and U.S. Patent Number 6,789,125 similarly discloses:

- <Claims 10, 20, and 30>

The method of claim 1, further comprising: the client using the URI and the schema in the advertisement to construct a gate for access to the service (claims 1, 2, 3, 4, 7, and 9 of U.S. Patent Number 6,643,650 in relation to claim 1 of the present application as discussed above and claims 1 and 2 of U.S. Patent Number 6,789,125).

Since the combination of U.S. Patent Number 6,643,650 and U.S. Patent Number 6,789,125 similarly discloses all of the above limitations, claims 10, 20, and 30 are rejected.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-5, 7-15, 17-25, and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Beck et al. (U.S. Patent Number 6,604,140), hereinafter referred to as Beck.

13. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a system or a carrier medium are rejected under the same rationale applied to the described claim.

14. Beck has disclosed:

- <Claims 1, 11, and 21>

A method comprising: a client reading an advertisement from a space, wherein the space comprises a network-addressable storage location (column 6, lines 1-16), wherein the advertisement comprises a Uniform Resource Identifier (URI) and a schema, wherein the URI specifies a network address at which a service may be accessed, and wherein the schema specifies one or more messages usable to invoke one or more functions of the

service (column 4, lines 40-60); and the client sending a first message to the service at the URI, wherein the first message is specified in the schema (column 6, lines 30-39).

- <Claims 2, 12, and 22>

The method of claim 1, further comprising: the service sending a second message to the client in response to the client sending the first message to the service, wherein the second message is specified in the schema (column 6, lines 41-44).

- <Claims 3, 13, and 23>

The method of claim 1, further comprising: invoking one or more functions of the service in response to the client sending the first message to the service (column 6, lines 39-41).

- <Claims 4, 14, and 24>

The method of claim 1, wherein the schema is expressed in a data representation language (column 5, lines 46-50).

- <Claims 5, 15, and 25>

The method of claim 1, wherein the first message is expressed in a data representation language (column 5, lines 54-61 and column 6, lines 30-39).

- <Claims 7, 17, and 27>

The method of claim 1, wherein the URI comprises an Internet address (column 4, lines 50-51).

- <Claims 8, 18, and 28>

The method of claim 1, further comprising: the service publishing the advertisement in the space (column 4, lines 31-39).

- <Claims 9, 19, and 29>

The method of claim 1, further comprising: the client using a lookup service to find the advertisement in the space (column 5, lines 65-67).

- <Claims 10, 20, and 30>

The method of claim 1, further comprising: the client using the URI and the schema in the advertisement to construct a gate for access to the service (column 7, lines 34-44).

Since all the limitations of the invention as set forth in claims 1-5, 7-15, 17-25, and 27-30 were disclosed by Beck, claims 1-5, 7-15, 17-25, and 27-30 are rejected.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 6, 16, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck in view of Official Notice.

17. The combination discloses:

- <Claims 6, 16, and 26>

The method of claim 5, wherein the data representation language comprises extensible Markup Language (XML) (Official Notice).

The use of XML as a data representation language in network communications systems was well known in the art at the time of the applicant's invention. Therefore, Official Notice is taken.

Since the combination of Beck and Official Notice discloses all of the above limitations, claims 6, 16, and 26 are rejected.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

- Isomursu et al. (U.S. Patent Number 6,400,958) disclosed a terminal in a communications network that is capable of supporting a plurality of applications and that can communicate user messages.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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